

REMARKS

Claims 1-4 are pending in the present application.

Finality of Examiner's Office Action

In the Office Action of July 11, 2003, the Examiner objected to the drawings and the Examiner made the Office Action final. Applicants had previously made minor amendments to the drawings in response to previous objections raised by the Examiner. But the objection to the drawings contained in the Office Action of Paper No. 8 was not necessitated by those minor amendments, nor had this objection been raised in the first, non-final office action. Accordingly, Applicants strenuously disagree with the Examiner's conclusion that a final Office Action is appropriate under the present circumstances and respectfully request that the finality of the Office Action of July 11, 2003 be withdrawn.

Objection to the Drawings

The Examiner has objected to the drawings for the following reasons:

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "press having platens" (claim 1, line 3) and all of the platens that associated with all of the regulating means in the claim must be shown or the feature(s) canceled from the claim(s). No new matter should be entered. (Office Action of July 11, 2003, Page 2, Emphasis in original).

Applicants believe that the Examiner has Incorrectly applied 37 CFR 1.83(a). Contrary to the Examiner's assertion, this section does not require that every element recited in the claims must also be shown in the drawings. The text of 37 CFR 1.83(a) reads as follows

The drawing in a nonprovisional application must show every feature of the invention specified in the claims. However, conventional features disclosed in the description and claims, where their detailed illustration is not essential for a proper understanding of the invention, should be illustrated in the drawing in the form of a graphical drawing symbol or a labeled representation (e.g., a labeled rectangular box).

Thus, even if a particular feature is specified in the claims, it is not necessary to show the feature in the drawings if both of the following conditions

are true: (1) the feature is a "conventional feature"; and (2) their detailed illustration is not essential for a proper understanding of the invention.

In the present case, both of these conditions are true. First, press platens are quite conventional features. There are thousands of patents in existence and extensive literature disclosing and documenting press platens. Press platens are among the most basic and fundamental elements of engineered wood manufacturing.

Second, it is not necessary to illustrate the platens in order to have a proper understanding of the invention. The present invention is directed to a press installation constructed to regulate the temperature of the press, and specifically the temperature of the press platens contained inside the press. (Paragraph 0015). The platens themselves have no direct role in the invention; they are mentioned only because the goal of the invention is to regulate their temperature more precisely, and because the invention is most useful (although not exclusively limited to) presses containing multiple platens.

Finally, the Examiner may make the argument that even if the platens are a conventional feature they nonetheless must be illustrated in the drawings by at least a graphical drawing symbol or labeled representation. Applicants maintain that they are indeed so illustrated. The claims recite "a press having platens." A press is specifically illustrated in the drawings by the use of a labeled rectangular box marked "PRESS". In view of this recitation in the claims and the description in the specification of the platens as being a component of the press, further illustration of the platens is unnecessary.

Therefore, based on the above remarks, the Examiner has failed to establish that the present drawings do not conform to the requirements of 37 C.F.R. §1.83(a). Reconsideration and withdrawal of the objection to the drawings are respectfully requested.

Objection to the Specification

The Examiner objected to the Specification because of minor informalities. By the current amendment, Applicants have presented a replacement paragraph 0024

correcting the informalities singled out by the Examiner. Accordingly, withdrawal of the objection to the specification is respectfully requested.

Objection to the Claims

The Examiner objected to claim 1 because of its inconsistent use of the terms "heating fluid" and "heating fluids". By the present amendment, Applicants have amended claim 1 to make the usage of these terms consistent with one another. Accordingly, withdrawal of the objection to the specification is respectfully requested.

Rejection under 35 U.S.C. §103

The Examiner has rejected claims 1-4 under 35 U.S.C. §103 as being obvious in view of the combination of McClure, Jr., U.S. Patent No. 4,365,547 ("McClure") and Eguchi, Japanese Patent Publication No. 40-2070406A ("Japan '406"). Applicants have summarized the construction and the inventive concept of the present invention on page 6 of the amendment filed on February 27, 2003. The teachings of McClure and Eguchi are summarized on pages 6-7 in the amendment filed on February 27, 2003.

In the Office Action of October 28, 2003 the Examiner asserts that McClure teaches all of the elements of claim 1 except for the element of claim 1 reciting a means for detecting the temperature of the heating fluids as it exits the platens. (Office Action of October 28, Page 3). However, the Examiner asserts that Japan '406 discloses a heating medium and a means for detecting the temperature as it exits the heating medium. The Examiner asserts that it would have been obvious to one having ordinary skill in the art to provide McClure's apparatus with the means for detecting the temperature as it exits the heating medium as taught by Japan '406 for the purpose of controlling the flow of heat medium.

Applicants have previously traversed this assertion on pages 8-9 of the amendment filed on February 27, 2003, and Applicants direct the Examiner's attention thereto, where this traversal is set forth in detail. The Applicants' traversal can be summarized as follows. First, Applicants assert that a *prima facie* case of obviousness has not been established because the Japan '406 reference upon which the Examiner has relied is not analogous prior art to the presently claimed subject matter and thus, applying Japan '406 to teach certain elements of the present claims is inappropriate. Second, one

of ordinary skill in the art would not have a reasonable expectation that McClure could be successfully combined with Japan '406 as suggested by the Examiner.

First in regards to the issue as to whether Japan '406 is analogous prior art, in the Office Action mailed July 11, 2003, the Examiner has maintained his position that Japan '406 is analogous art arguing that. Applicants have previously noted the following criteria for determining what is analogous prior art:

The examiner must determine what is "analogous prior art" for the purpose of analyzing the obviousness of the subject matter at issue. "In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." (M.P.E.P. §2141.01(a)) (citations omitted).

First, Applicants note that the Examiner does not attempt to show that the reference is reasonably pertinent to the particular problem with which the inventor was concerned. Second, Applicants believe that the Examiner has not sufficiently defended his assertion that Japan '406 is analogous art to the present invention. In supporting his assertion that Japan '406 is analogous art to the present invention, the Examiner has written:

the Japan '406 discloses a molding press using molding die/platen. Because the Japan '406 teaches a molding press, the prior art reference is analogous (pressing art). (Office Action of July 11, 2003, page 3.).

In determining whether the present invention and Japan '406 belong to the same arts, particular attention is commended to the existence of structural and function similarities between the present invention and the prior art. (See M.P.E.P. §2141.01(a).) No such structural or functional similarities have been adduced.

First, the function of Japan '406 and the present invention are very different. While the press in Japan '406 is directed to making molding products, the press in the present invention is designed to compress a wood-additive mixture (or some similar composite material) into pressed boards or other composite products. This would in turn lead to entirely separate systems of communicating a heating-regulating fluid into the interior of the press, further differentiating the function of the two respective presses.

As for the structure of the two devices, that is more difficult to determine because the Japan '406 reference does not illustrate the internal structure of its press nor does the abstract to the document that the Examiner relies on describe the press in greater detail. This lack of clarity on the part of the '406 reference militates against the assertion that the '406 reference is part of an analogous art, because it is the Examiner's burden to demonstrate that Japan '406 and the present invention are analogous.

The Examiner argues the existence of an analogous relationship because Japan '406 and the present invention are both part of the "pressing art". But the Examiner has never established the existence of a coherent body of work referred to as: the "pressing art". The "pressing art" could include a variety of devices that press not only molded products and wood-additive mixtures, but also a number of other articles that are commonly "pressed": e.g., clothing and linens, waffles, wine grapes, books, newspapers, olives, coffee, and deciduous tree leaves.

Accordingly, the Examiner has failed to establish that Japan '406 is analogous prior art to the present invention.

Further, Applicants have also argued that one of ordinary skill in the art would not have a reasonable expectation that McClure could be successfully combined with Japan '406 as suggested by the Examiner.

In response to this argument, the Examiner has replied:

[t]he test of obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teaching of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 U.S.P.Q. 871 (C.C.P.A. 1981). (Office Action of July 11, 2003, Pages 3-4).

Applicants respectfully traverse the Examiner's argument. Applicants believe that the Examiner has misstated the obviousness considerations for combining two prior art references and has also misstated the Applicant's argument.

First, Applicants wish to explain how the Examiner has misstated the obviousness considerations. The Examiner writes above that, "the test is what the combined teaching of the references would have suggested to those of ordinary skill in the art." This is not the correct test for obviousness, because it omits the required initial inquiry

that must occur first as to whether it would have been obvious to combine two prior art references. (Only after completing such an inquiry in the affirmative, does one then ask what the combined references implicitly and explicitly teach).

Thus, in order to establish *prima facie* obviousness based on a combination of prior art references, the Examiner must first show that there is some reasonable expectation for successfully combining the references in the manner suggested by the Examiner. This reasonable expectation would not exist if the proposed combination renders the prior art unsatisfactory for its intended purpose. M.P.E.P. §2143.01.

In the present case, combining McClure and Japan '406 in the manner suggested by the Examiner renders the prior art unsatisfactory for its intended purpose. McClure and Japan '406 place the temperature regulating means in exactly opposite locations: in Japan '406 the temperature of the heat medium is taken, and the temperature adjusted, after it exits the die and the heat medium. By contrast, in McClure, the heat medium temperature is detected before the heat medium is directed into the press. (Col. 4, lines 7-30). Thus, in order to carry out the Examiner's proposed modification (i.e., to modify McClure so that the McClure apparatus detects the heat medium temperature as it exits the apparatus) it would be necessary to move McClure's temperature detecting and regulating means from its current position, to a new position downstream of the McClure apparatus. This would appear to render the McClure device not only inoperable, but also unsatisfactory for its intended purpose, as it appears that a necessary aspect of the McClure device is that the blow-off valve 8 be located on the opposite side of the laminating press of the steam valve 12. Thus, the proposed combination suggested by the Examiner renders the prior art unsatisfactory for its intended purpose, and one of ordinary skill in the art would not have a reasonable expectation that McClure could be successfully combined with Japan '406 as suggested by the Examiner.

Therefore, based on the above remarks, the Examiner has failed to establish that claims 1-4 are obvious in view of McClure and Japan '406. Reconsideration and withdrawal of the rejections of claims 1-4 are respectfully requested.

CONCLUSION

Reconsideration and withdrawal of the objection and rejection of the claims in view of the remarks provided herein and allowance of the claims being prosecuted are respectfully requested.

Respectfully submitted,

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David M. Goodrich
David M. Goodrich
Reg. No. 42,592

J. M. Huber Corporation
333 Thornall Street
Edison, NJ 08837-2220
Telephone: (732) 603-3674
Facsimile: (732) 603-8730

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